

REMARKS

Claim 101 has been amended by deleting an extra period. Claims 2-27, 31-42, 44-51, 53-58, 60-78, 81-95, 101, 102, 105, 106 and 109-112 are currently pending, although claims 53-57, 60 and 61 have been withdrawn from consideration. Because the withdrawn claims ultimately depend from non-withdrawn claims, Applicant currently intends to seek rejoinder of the withdrawn claims pursuant to MPEP § 821.04 upon indication of allowable subject matter.

The Office Action rejected claims 5-10, 31-35, 37-42, 44-51, 58, 62, 63, 65-70, 81-83, 85-95, 101-103, 105, 106 and 109-112 under 35 U.S.C. 103 as obvious over U.S. patent 5,738,841 (“Mellul”) in view of EP 548694 (“Nojima”); claims 2-4, 11-19, 21-27, 36, 64, 71, 72, 74-78 and 84 under 35 U.S.C. 103 as obvious over Mellul and Nojima in view of U.S. patent 5,690,918 (“Jacks”); claims 20 and 73 under 35 U.S.C. 103 as obvious over Mellul, Nojima and JP 63119412 (“JP 412”). In view of the following comments, Applicant respectfully request reconsideration and withdrawal of these rejections.

Once again, the Office has resurrected rejections which had initially been raised years ago and which had been overcome, the result of which is a continued unfair prolongation of the prosecution of this case.

Previously, the Office rejected the claims in this application as obvious over Nojima in view of Mellul. (See, for example, Office Action dated February 21, 2008, the most recent time this rejection was raised). By virtue of Applicants’ July 2008 response, this rejection was overcome. (See, for example, Office Action dated November 18, 2008, in which this rejection was withdrawn).

In an attempt to justify resurrecting this rejection and labeling it as a “new” rejection, the Office attempted to explain why the combination of Mellul with Nojima differs from the combination of Nojima with Mellul at page 5 of the most recent Office Action. However, this explanation merely sets forth a distinction without a difference, and is not persuasive. The rejection is the same, and this rejection has already been overcome. Accordingly, the rejection should be withdrawn again.

The Office (at page 5) asserted that one of ordinary skill in the art would be motivated by Nojima to produce a composition without volatile oils and, thus, would have been motivated to modify Mellul such that it did not contain volatile oils. The primary problem with the Office's assertion is that the only motivation provided by Nojima would be to do so using alkoxylated silicone compounds, compounds which are specifically excluded from the present invention. In other words, Nojima would not have, and could not have, motivated one skilled in the art to produce the claimed compositions having both (1) little or no volatile oil; and (2) no alkoxylated silicone compound -- according to the teachings of Nojima, compositions either had to have one or the other.

For sake of completeness, Applicant reiterates that Nojima requires the presence of alkoxylated silicone compounds. The amount of alkoxylation in Nojima's silicone compounds is “from 1 to 50% by weight, preferably from 5 to 40% by weight.” (Page 3, lines 49-50. See also, page 4, lines 21-24). As explained in the Rule 132 declaration submitted previously in this case, such alkoxylated silicone compounds are non-volatile. Thus, Nojima requires the presence of an alkoxylated, non-volatile silicone compound.

In sharp contrast, all of the pending claims exclude the presence of such alkoxylated, non-volatile silicone compounds. That is, by virtue of (1) the language in the present claims requiring the non-volatile silicone component to “consist of” the specified non-volatile silicone compounds, meaning that the only non-volatile silicone compounds which may be present in the claimed compositions are those identified in the claims; and (2) the fact that the specified non-volatile silicone compounds do not include alkoxylated silicone compounds, the claims require the presence of a non-volatile silicone component which does not include alkoxylated silicone compounds. Because Nojima requires the presence of alkoxylated, non-volatile silicone compounds, Nojima cannot teach or suggest the claimed silicone component, meaning that Nojima cannot teach or suggest the claimed invention.

Mellul is also fatally deficient. For example, the combination of Nojima with Mellul would necessarily result in a composition containing an alkoxylated, non-volatile silicone compound given Nojima’s teachings. In sharp contrast, all of the pending claims exclude the presence of such alkoxylated, non-volatile silicone compounds. For at least this reason, the combination of Nojima and Mellul does not set forth a *prima facie* case of obviousness.

Furthermore, one skilled in the art, following the teachings of both of these references, would not have been motivated to combine them given the highly specific nature of their disclosures: Nojima relates only to alkoxylated, non-volatile silicones, while Mellul relates to “surprisingly” homogeneous compositions containing non-alkoxylated silicones. Given the specificity of their disclosures, nothing in either of these references would have suggested that only non-alkoxylated silicones could be

used in Nojima's compositions or that only alkoxylated silicones could be used in Mellul's compositions to yield a "surprisingly" homogeneous composition.

Neither Jacks nor JP 412 suggests modifying Nojima's and/or Mellul's compositions to yield the claimed invention.

Regarding Jacks, as previously discussed (see, for example, Applicant's response filed November 16, 2005), Jacks relates to transfer-resistant compositions, and typically in such compositions volatile oil evaporates after application to form a transfer-resistant film. Jacks recognizes this crucial role of volatile oils in his transfer-resistant compositions, stating that volatile oils contribute to the "wear characteristics" of his compositions. (Col. 4, lines 10-11). This is presumably why Jacks teaches and exemplifies that substantial amounts of volatile oil should be present in his compositions, most preferably between 40-50%. (Col. 4, line 38).

One of the practical differences between the claimed invention and Jacks is that the claimed invention permits formation of a transfer-resistant film using a composition containing little or no volatile oil, whereas Jacks requires the presence of a substantial amount of volatile oil. One skilled in the art, seeking to create a transfer-resistant film, would not be motivated by Jacks to remove or reduce volatile solvent because removing volatile solvent would affect the wear-characteristics of these transfer-resistant products. In other words, Jacks would lead one skilled in the art away from the claimed invention.

JP 412, which is cited merely for its disclosure relating to 12-hydroxystearic acids, cannot compensate for Nojima's and/or Mellul's deficiencies as well.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 103 based upon Nojima, Mellul, Jacks and JP 412.

Applicant believes that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

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